

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>06727/000H417-US0</b>	
		Application Number <b>09/616,977-Conf. #7345</b>	Filed <b>July 14, 2000</b>
		First Named Inventor <b>Aviad Zlotnick</b>	
		Art Unit <b>2178</b>	Examiner <b>K. R. Stork</b>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <b>25,351</b></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p>			
 <b>S. Peter Ludwig</b> <small>Typed or printed name</small>			
<small>(212) 527-7770</small> <small>Telephone number</small> <b>May 1, 2007</b> <small>Date</small>			
<small>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</small>			
<input type="checkbox"/> *Total of <b>1</b> forms are submitted.			

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Aviad Zlotnick

Application No.: 09/616,977

Confirmation No.: 7345

Filed: July 14, 2000

Art Unit: 2178

For: DIRECTOR SERVICE FOR FORM  
PROCESSING

Examiner: K. R. Stork

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

*I. Introductory Comments*

Claims 1, 4-19 and 22-37 are pending in this application. Claims 1, 12, 19, 30, 35 and 37 are independent claims.

In an Official Action dated February 1, 2007, all of the claims in this application were finally rejected under 35 U.S.C. 103(a) over Lorie (U.S. Patent 5,933,531) in view of Jansen et al. (U.S. Patent 6,243,450) and/or DiPiazza (U.S. Patent 6,028,970). Appellant respectfully submits that the cited references fail to teach, or even to suggest, every element of the independent claims in this application. Accordingly, Appellant requests that the application be allowed on the existing claims or, in the alternative, that prosecution on the merits of the claims be reopened with a non-final Official Action.

*II. Rejection of independent claims 1, 19 and 35 over Lorie in view of Jansen*

Claim 1 recites a method for providing a document processing service that was new at the time this application was filed, nearly seven years ago. The method is directed to processing documents in a particular domain, for which a directory of related data is defined. As explained in the specification (page 4), this service enables a client who is not expert in image processing and

does not have convenient access to appropriate, focused directories to obtain high-quality coding results without a major investment in acquiring new infrastructure or capabilities.

To use the service, the client sends images of fields over a computer network for processing. The images are processed to code the information, and the coded information is checked for correctness by lookup in the directory. The checked, coded information is returned over the network to the client, who pays for the coding and checking according to the number of fields processed, at a certain price per field. This novel model of payment, which has benefits for both the client and the service provider, was likewise not known at the time this application was filed.

The references cited by the Examiner fail to teach or even to suggest the novel features of the claimed invention, let alone the possibility of their combined use in providing a network-based service to a client:

- (1) The cited references make no mention of any sort of client, nor do they mention or even suggest that images might be sent over a computer network and coded information returned over the network.
- (2) The cited references neither mention nor suggest the possibility of charging a client for any sort of service on the basis of a price per field.

The Examiner's argument in response to the first of these points boils down to the assertion that "Lorie still provides one possible embodiment of the invention as the invention in a networked environment" (page 10 in the Official Action). This assertion is based solely on Lorie's recitation, quoted by the Examiner, that his invention "may be implemented using standard programming and/or engineering techniques... Any such resulting program(s)... may be embodied or provided within... any transmitting/receiving medium... thereby making a computer program product..." (col. 8, lines 51-62). This passage relates to nothing more than transmission of operating software over a network. It does not disclose or suggest anything at all with regard to transmission of images or receipt of coded information by a client.

Even if it were granted, for the sake of argument, that Lorie could operate in a network environment, there is still no suggestion that Lorie could or should be modified in this manner. In this regard, MPEP 2143.01(III) states:

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

The Examiner's statement that "Lorie... provides one possible embodiment of the invention as the invention in a networked environment" is no more than an unsupported assertion that Lorie could be modified to operate in the manner recited in claim 1. MPEP and the case law make clear that this sort of assertion is not sufficient to support a finding of *prima facie* obviousness.

With regard to point (2) above, the Examiner acknowledged that Lorie does not disclose receiving payment based upon a price per field (or per any other unit of service), but held that Jansen discloses this element of claim 1 in his abstract. In the cited passage, however, Jansen describes charging for a multimedia service at a certain cost per unit time. Jansen is directed to vending public multimedia services, not processing fields of information. He therefore could not possibly have suggested using the number of fields processed as a basis for payment, as recited in claim 1.

In response to this point in the Official Action (page 10, second paragraph), the Examiner could say only that "Jansen discloses receiving payment for a service based upon a price per unit... A field is a unit. Therefore, a price per field is within the scope of a price per unit." The Examiner's position appears to be, in other words, that any method of charging for a service based on a price per unit must now be obvious, even if the service is different and the units are different from those disclosed in the prior art. Here again, the Examiner has overlooked the dictates of the law, as summarized in MPEP 2143.03:

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

Neither Jansen nor Lorie teaches or suggests all the limitations of claim 1.

Thus, to summarize, the Examiner has failed on a number of counts to make a case of *prima facie* obviousness against claim 1. Therefore, claim 1 is clearly patentable over the cited art.

Independent claims 19 and 35 respectively recite apparatus and a computer software product that operate on principles similar to the method of claim 1. These independent claims are therefore believed to be patentable over the cited art for the reasons explained above.

*III. Rejection of independent claims 12, 30 and 37 over Lorie in view of DiPiazza*

Claim 12 recites a novel method for providing a form processing service to clients via a network. The forms are filled in with information in a predefined domain. A directory is defined in advance for the domain by selecting data specific to the domain from one or more general databases. The information that is filled into a field on the forms is then checked for correctness by lookup in the directory. As explained in the specification (page 3), the use of this sort of specific, focused directory enables the service to search and check the coded information with greater reliability and speed than are generally achievable with general-purpose databases. As in the case of claim 1, this service enables a client who is not expert in image processing and does not have convenient access to appropriate, focused directories to obtain high-quality coding results without a major investment in acquiring new infrastructure or capabilities.

In rejecting claim 12, the Examiner again maintained that Lorie discloses receiving information from a client via a computer network. As pointed out above in reference to claim 1, however, Lorie neither mentions nor suggests communication with a client over a network. Lorie does not even hint at receiving from such a client information that is filled into a field on forms that are to be processed, nor does DiPiazza supply this missing teaching. Thus, for this reason alone, claim 12 should have been allowed over the cited art.

Furthermore, neither of the cited references teaches or suggests using a domain-specific directory for checking correctness of information. Rather, both Lorie and DiPiazza use information lookup in general databases, as was known in the art at the time the present patent application was filed. DiPiazza, for example, describes data verification using a database enhancement module, which stores data values such as area codes, credit card and bank account information, and customer names (col. 8, line 51 – col. 9, line 15). Values of these sorts are taken from general databases. There is not the slightest suggestion, in either Lorie or DiPiazza, of defining the directory for a predefined domain by selecting data specific to the domain from such general databases, as is recited in claim 12.

Although DiPiazza himself describes the use of databases in data verification, the Examiner chose another element of DiPiazza's method – the "rule base" – to equate with the directory of claim 12. This interpretation, however, is contrary to the clear, literal sense of DiPiazza himself, who presents his information-lookup database and his rule bases as separate and distinct entities (as shown, for example, in col. 9, lines 16-28). Moreover, even if the Examiner's contrary

interpretation of DiPiazza were to be adopted, there is still no suggestion in DiPiazza of defining a rule base by selecting rules specific to the domain from a “general rule base,” as would be required for parallelism with claim 12. The fact that DiPiazza may have rule bases that are specific to certain context types does not mean that they are selected from a general rule base, nor does DiPiazza teach or suggest that there might be a general rule base of this sort.

Thus, the cited references do not disclose all of the elements of the method of claim 12, nor has the Examiner shown any suggestion in the prior art to modify the cited references in order to arrive at this method. Therefore, claim 12 is clearly patentable over Lorie in view of DiPiazza.

Independent claims 30 and 37 respectively recite apparatus and a computer software product that operate on principles similar to the method of claim 12. These independent claims are therefore believed to be patentable over the cited art for the reasons explained above.

*IV. Rejection of dependent claims 4-11, 13-18, 22-29, 31-34 and 36*

Appellant believes the dependent claims in this application to recite independently-patentable subject matter. In the interest of brevity, however, Appellant will defer further argument regarding the dependent claims to the Appeal Brief, in the event that this application proceeds to appeal.

*VI. Conclusion*

In view of the above remarks, Appellant respectfully submits that all of the claims in the present application are in order for allowance. Notice to this effect is hereby requested.

Dated: May 1, 2007

Respectfully submitted,

By

S. Peter Ludwig

Registration No. 25,351

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(212) 527-7700

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant